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Paper No. 11
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Oren Benmoshe

Serial No. 75/434,997

Christie Gaumer for Oren Benmoshe.

Douglas M. Lee, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Quinn, Bucher and Bottorff, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant seeks registration of the mark "E-MALE AMERICA"
(with the word "America" disclaimed) for goods identified in
the application as "shirts, pants, jackets, shorts, sweaters
and T-shirts," in International Class 25.¹

The Trademark Examining Attorney has refused registration
under Trademark Act Section 2(d), 15 U.S.C. §1052(d), citing

¹ Serial No. 75/434,997, filed February 17, 1998. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), with July 5, 1997 alleged as the date of first use of the mark anywhere and September 15, 1997 alleged as the date of first use of the mark in commerce.

Registration No. 2,097,356, which is for the mark "E-MAIL and design" as shown below:



for goods identified as "articles of clothing, namely, T-shirts, gloves, dresses, pull-overs, sweat shirts, sweat pants, caps, hats, vests, anoraks, skirts, shirts, blouses, tights, scarves, trousers, long underpants (for women), socks; footwear and headwear, all for men and women," also in International Class 25,² as a bar to registration of applicant's mark.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We affirm the refusal to register.

Applicant argues that the realities of the marketplace are that applicant sells inexpensive men's clothing through mass-market stores, while registrant sells extremely expensive footwear to women solely through specialty boutiques.

² Reg. No. 2,097,356, issued on September 16, 1997 to a French corporation, maturing from application Ser. No. 75/149,279, filed on August 5, 1996. The registration was filed under Sec. 44(d) with a priority date of February 13, 1996, and ultimately issued under Section 44(e) of the Act.

Applicant also maintains that the marks are visually and phonetically quite distinct, and that the connotations of these two marks, as applied to their respective goods, are quite different.

The Trademark Examining Attorney contends that the dominant term in applicant's mark is "E-MALE," which is phonetically equivalent to the literal portion of registrant's mark. As spoken, both will create connotations of electronic mail.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to a consideration of the goods. It is well settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods as they are identified in the involved application and cited registration, rather than on what any evidence may show as to the actual nature of the goods, their channels of trade and/or classes of purchasers. Canadian

Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and In re Elbaum, 211 USPQ 639 (TTAB 1981). The goods as identified are identical in certain respects, namely, shirts, T-shirts and pants/trousers. The balance of the clothing items enumerated in the respective lists of apparel must all be deemed to be closely related. In sum, given the overlap as to some items and the substantial similarity between the other clothing items, confusion is likely to occur if these items were sold under the same or similar marks. The decisions in this field have held many different types of apparel related under Section 2(d). See Kangol Ltd. v. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992) [the goods of the respective parties are likely to be sold in department stores or specialty shops in close proximity to each other]; and Cambridge Rubber Co. v. Cluett, Peabody & Co., Inc., 286 F.2d 623, 128 USPQ 549 (CCPA 1961) [women's boots related to men's and boys' underwear].

Turning to a consideration of the marks, we note at the outset that if the goods are identical, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Further, in considering the marks, we recognize that the geographically descriptive (and disclaimed) "AMERICA" portion of applicant's mark cannot be ignored. Giant Food, Inc. v. National Food Service, Inc., 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). However, although we have resolved likelihood of confusion by a consideration of the marks in their entireties, there is nothing improper in giving more weight, for rational reasons, to a particular feature of a mark. In re National Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this case, we have given more weight to the arbitrary "E-MALE" portion of applicant's mark, which is quite similar to the entire literal portion of registrant's mark, "E-MAIL." The addition of this geographically descriptive matter to one of two otherwise similar marks will not serve to avoid a likelihood of confusion, mistake or deception.

Applicant argues that the marks are phonetically quite different. However, when spoken, the entire wording in registrant's mark ("e-mail") is identical to the dominant portion of applicant's mark ("E-MALE" on the typed drawing, "e?male" on the specimens of record). The similarity in sound arising from the phonetic identity of "E-MAIL" and "E-MALE" is not negated by the addition of the geographically descriptive term, "AMERICA." Viewed in their entireties, these two marks

are more similar than dissimilar because the only point of dissimilarity results from a non-distinctive, subordinate feature of applicant's mark.

Registrant's mark "E-MAIL and design" and applicant's mark "E-MALE AMERICA" are also similar in appearance. "E-MALE" comprises the first part of applicant's typed drawing and would be the portion of the mark consumers will notice first. Additionally, as noted above, we have rational reasons to accord less weight to the geographically descriptive, disclaimed term "AMERICA" in applicant's composite mark. Furthermore, a typed drawing permits applicant to display its mark in a variety of styles. In this regard, we note that the specimens of record show the word "AMERICA" in much smaller letters, and spatially, in a subordinate position, to the larger, much more prominent term, "e?male." In this specimen, applicant has also chosen a lower case presentation of "e?male," exactly as registrant does with "e?mail" in its special form drawing. Finally, the slight stylization of registrant's composite mark does little to distinguish it from applicant's mark. Registrant's "e?mail" mark is shown in special form within an oval border, but the appearance of this oval carrier device is certainly not unusual. Hence, such a common shape is simply not sufficient to distinguish applicant's mark from registrant's mark.

Finally, as to the third part of the trilogy, meaning, we find that applicant's mark, "E-MALE AMERICA," and registrant's mark, "E?MAIL and design," when viewed in their entirety, as applied to these identical and/or substantially similar goods, engender similar overall commercial impressions. Although the words "mail" and "male" have specific and distinct meanings, applicant's coined term, "e-male," like the well-known term, "e-mail," plays on the common suggestion of electronic communications over the Internet.³ In this Internet age, even taking into consideration the different spellings, "E-MAIL" and "E-MALE" will convey essentially identical connotations. Applicant disagrees, arguing it is important in this context that all of its listed goods are targeted to a "male" audience (although the identification of goods is not so limited). This does provide another logical connotation for the spelling of the "... male" portion of applicant's mark. However, to our knowledge, applicant has simply coined this playful variant of the well-known term, "e-mail." Hence, there is no commonly known meaning for "e-male," and this spelling variation, when viewed within the context of the entire mark, will not detract

³ This is easily distinguished from the facts in Gulf States Paper Corp. v Crown Zellerback Corp., 417 F.2d 795, 163 USPQ 589 (CCPA 1969), a case cited by applicant, where "CZ" cannot be said similarly to call to mind "E-Z."

significantly from the Internet/electronic mail connotation consumers will automatically attach to applicant's mark.

Accordingly, we find that the similarities in sound, appearance and overall commercial impressions simply outweigh the differences detailed by applicant.

Additionally, in finding that the marks are likely to cause confusion, we have kept in mind the normal fallibility of human memory over time and the fact that ordinary consumers who are potential purchasers of this type of apparel retain a general rather than a specific impression of trademarks encountered in the marketplace. In spite of applicant's claim that we should take notice of totally disparate marketing channels and of the expense of registrant's specialty goods, in the absence of any limitations in the identifications of goods, we must assume that some of registrant's clothing items as listed in its registration are fairly inexpensive and hence are not bought by particularly sophisticated purchasers.

In examining the number and nature of similar marks in use on similar goods, there is no evidence in the record of similar marks in the marketplace on related goods or services. Hence, we deem registrant's "E-MAIL" mark to be a strong source indicator in the apparel field.

To the extent that any of the specific differences between the marks may cast doubt on our ultimate conclusion on

the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. See In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

We conclude that purchasers familiar with registrant's clothing items sold under its mark "E-MAIL and design" would be likely to believe, upon encountering applicant's mark "E-MALE AMERICA" for identical and closely-related items of apparel, that this clothing originated with or is somehow associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.

T. J. Quinn

D. E. Bucher

C. M. Bottorff

Administrative Trademark
Judges, Trademark Trial and
Appeal Board